

MS APPEAL BRIEF - PATENTS

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0879-0230P

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BA 12/19/03

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of

Before the Board of Appeals

Atsushi MISAWA

Appeal No.:

Appl. No.: 09/286,906

Group: 2612

Filed: April 6, 1999

Examiner: L. NGUYEN

Conf.: 5582

For: CAMERA WITH MONITOR

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Technology Center 2600

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MS APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

November 26, 2003

Sir:

Transmitted herewith is an Appeal Brief (in triplicate) on behalf of the Appellants in connection with the above-identified application.

- ☐ The enclosed document is being transmitted via the Certificate of Mailing provisions of 37 C.F.R. § 1.8.

A Notice of Appeal was filed on September 29, 2003.

- ☐ Applicant claims small entity status in accordance with 37 C.F.R. § 1.27

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Appl. No. 09/286,906

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Respectfully submitted,

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Attachment(s)

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**APPEAL BRIEF ON BEHALF
OF APPELLANT:
ATSUSHI MISAWA**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

November 26, 2003

Sir:

I. REAL PARTY IN INTEREST

The real party in interest for this application is the Assignee, Fuji Photo Film Co., Ltd., No. 210 Nakanuma, Minami-Ashigara-shi, Kanagawa, JAPAN.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences pending with respect to the subject matter of the present application.

III. STATUS OF CLAIMS

Claims 1-12 remain pending. Claims 1 and 10 are independent. No claims have been allowed. Claim 5 contains allowable subject matter.

IV. STATUS OF AMENDMENTS

A Reply After Final was filed on September 4, 2003, adding new claim 13. The Reply was denied entry. New claim 13 is not discussed herein.

V. SUMMARY OF THE INVENTION

The invention of the subject application is a camera, including a monitor which operates in a plurality of modes including a recording mode and a reproducing mode. The monitor includes a plurality of areas wherein depending upon which mode the camera is in, the image is reproduced in a particular area of the monitor. An embodiment of the present invention includes an imaging part 12, a signal processing part 34, a recording part 36, including a built-in memory or a detachable external memory, an output memory 38, a D/A converter 40, a monitor 30, a touch panel 32, and a central processing unit 42. [Page 5, lines 7-11].

The signal processing part 34 processes the image signal read from either the imaging part 12 or the recording part 36, and the image signal is transmitted to the output memory 38. The image is displayed on the screen of the monitor 30. The monitor 30 shows not only a still image, which is designated to be recorded by pressing the recording button 20, but to preview images before the recording button 20 is pressed such as a motion picture and

an intermittent motion picture. [Page 5, lines 20-26]. The camera further includes a mode switch 22 which is used to switch the function or mode of the camera 10. The mode switch may set a recording mode when placed in upper position A or in reproducing mode when positioned in lower position B. [Page 4, line 16 - page 5, line 1].

When the recording mode is selected with the mode switch 26, a reduced preview image is displayed at the left of the screen of the monitor 30 in Fig. 4 such that the preview image is displayed on an area of the monitor 30 excluding an area covered and hidden with the hand 46 of the operator holding the grip 18. In the recording mode, the operator usually holds the grip 18 with the right hand as shown in Fig. 4. In this case, the hand of the operator covers an area of the screen of the monitor 30 (at the right end of the monitor 30 in Fig. 4). If the image is displayed on the covered area, the operator cannot see the image or recognize the composition of the whole image. If the operator changes the positions of the hand 46 to uncover the whole screen on the monitor 30 the camera cannot be held steadily. To address this problem, the image is reduced and displayed at the left of the screen to exclude the area covered with the hand 46. Consequently, the operator can look at the whole image while holding the camera 10 steadily. [Page 6, line 20 - page 7, line 6].

The area where the image is displayed in the recording mode is predetermined in view of the normal camera holding period. Alternatively, the touched area of the monitor 30 is determined with the touch panel 32, and the

image display area is bounded to excluded the touched area. [Page 7, lines 7-10].

When the reproducing mode is selected with mode switch 26, the reproduced image is displayed on the entire area of the monitor 30. If a part of the screen is used as the operational part with the touch panel 32, the reproduced image is displayed on substantially the entire area except for the operational part. [Page 8, lines 1-5]. When the reproduced image is displayed on the monitor 30 in the reproducing mode, the operator usually holds the electronic camera 10 in the palm of the hand as shown in Fig. 6. Since it is unnecessary to direct the imaging part 12 to the subject, the operator can hold the camera 10 without covering the monitor 30. Thus, the dynamic reproduced image can be displayed on substantially the entire screen of the monitor as shown in Fig. 6 in the reproducing mode. [Page 8, lines 11-17].

The reproduced image is read from the recording part 36 or a storage medium of the external equipment can be switched by operating the frame switching buttons 22 during the reproducing. Operating one of the frame switching buttons 22 switches the reproduced images on a frame-by-frame basis in a recorded order, and operating the other of the frame switching buttons 22 switches the reproduced images on a frame-by-frame basis in an order reverse to the recorded order. [Page 8, lines 17-23].

In one embodiment, the touch panel is provided over the monitor, and the operation buttons such as the exposure correcting button and the zoom operation button are displayed in the area where no image is displayed in the

recording mode. Therefore, the screen of the monitor can be used as the operational part. [Page 10, lines 2-5].

As such, the camera of the present invention has a monitor with a large screen and displays the reduced image only in the area where there is little possibility of being covered by the hand of the operator in the recording mode. In the reproducing mode, the large image is displayed on substantially the entire screen of the monitor. Thus, the operator can see the dynamic image in the reproducing mode and easily confirm the composition of the image in the recording mode. [Page 9, line 23 - page 10, line 1].

This description of the invention has been submitted to comply with the Patent Office rules for submitting Appeal Briefs. This summary of the invention should not be considered as limiting the claimed invention.

VI. THE GROUNDS OF REJECTION

The Examiner has rejected all pending claims as follows:

1. Claims 1, 6-9, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. US2002/0008763A1 to *Kawamura et al.* (hereinafter "*Kawamura*") in view of Japanese Patent Application Publication No. 01-320871 to *Oku et al.* (hereinafter "*Oku*");

2. Claims 2-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kawamura* in view of *Oku* and further in view of U.S. Patent No. 5,515,104 to *Okada* (hereinafter "*Okada*"); and

3. Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kawamura* in view of U.S. Patent No. 6,169,568 to *Shigetomi* (hereinafter “*Shigetomi*”).

4. Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kawamura* in view of *Shigetomi* and further in view of *Okada*.

VII. ISSUES ON APPEAL

The issues to be resolved in this Appeal are:

- (1) Whether claims 1, 6-9, and 12 are unpatentable under 35 U.S.C. § 103 based on the teachings of *Kawamura* in view of *Oku*;
- (2) Whether claims 2-4 are unpatentable under 35 U.S.C. § 103 based on the teachings of *Kawamura* in view of *Oku* and further in view of *Okada*;
- (3) Whether claim 10 is unpatentable under 35 U.S.C. § 103 based on the teachings of *Kawamura* and *Shigetomi*; and
- (4) Whether claim 11 is unpatentable under 35 U.S.C. § 103(a) based on the teachings of *Kawamura*, *Shigetomi*, and *Okada*.

VIII. GROUPING OF CLAIMS

The claims should be grouped as follows for the purposes of this Appeal:

1. Claims 1, 9, and 12 stand or fall together;
2. Claim 2 is separately grouped and argued;
3. Claim 3 is separately grouped and argued;

4. Claim 4 is separately grouped and argued;
5. Claim 6 is separately grouped and argued;
6. Claim 7 is separately grouped and argued;
7. Claim 8 is separately grouped and argued;
8. Claim 10 is separately grouped and argued; and
9. Claim 11 is separately grouped and argued.

IX. ARGUMENT

A. Issue (1): The *Kawamura-Oku* Rejection

1. Argument Summary

The reasoning provided in support of the rejection of claims 1, 6-9, and 12 under 35 U.S.C. § 103(a) as being unpatentable over *Kawamura* in view of *Oku* fails to establish *prima facie* obviousness. Generally, the deficiencies of the rejection are that: (a) the rejection attributes certain claimed features to the primary reference, *Kawamura*, that a detailed reading of the reference reveals are not taught therein; (b) when the nature and purpose of the display technique disclosed by *Kawamura* is recognized, it is evident that there is no suggestion or motivation in either of the references cited in support of the rejection or in knowledge generally available to those skilled in the art to modify *Kawamura* in a manner asserted by the rejection; and (c) by asserting that certain modifications to the electronic camera of *Kawamura* would have been obvious without a proper suggestion or motivation in the applied references or elsewhere to make the asserted modifications, the rejection

appears to rely on impermissible hindsight reasoning. Such deficiencies exist for the rejection of each of claims 1, 6-9, and 12.

2. The Legal Requirements of *Prima Facie* Obviousness

To establish *prima facie* obviousness, all claim limitations must be taught or suggested by the prior art and the asserted modification or combination of the prior art must be supported by some teaching, suggestion, or motivation in the applied references or in knowledge generally available to one skilled in the art. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The prior art must suggest the desirability of the modification in order to establish a *prima facie* case of obviousness. In re Brouwer, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1995). It can also be said that the prior art must collectively suggest or point to the claimed invention to support a finding of obviousness. In re Hedges, 783 F.2d 1038, 1041, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Ehrreich, 590 F.2d 902, 908-909, 200 USPQ 504, 510 (C.C.P.A. 1979).

The teaching or suggestion to make the asserted combination or modification of the primary reference must be found in the prior art and cannot be gleaned from applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In other words, the use of hindsight to reconstruct the claimed invention is impermissible. Uniroyal Inc. v. Rudlan-Wiley Corp., 5 USPQ 1434 (Fed. Cir. 1983).

Finally, when considering the differences between the primary reference and the claimed invention, the question for assessing obviousness is not whether the differences themselves would be been obvious, but instead whether the claimed invention as a whole would have been obvious. Stratoflex Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983).

3. The Rejection Fails to Establish *Prima Facie* Obviousness of Independent Claim 1

Independent claim 1 is directed to a camera comprising, *inter alia*, an imaging part; a selector; a recording part for recording the image captured by the imaging part on a recording medium upon receiving a command to record in the recording mode; a reproducing part for reproducing an image from the recording medium in the reproducing mode; a monitor for displaying the image; and a display controller for controlling the monitor to display the image captured by the imaging part on a first area on the monitor in the recording mode and to display the image reproduced from the recording medium on a second area on the monitor in the reproducing mode, the first area being smaller than the second area.

In maintaining the rejection of independent claim 1 based on *Kawamura* and *Oku*, the Final Office Action asserts on page 2 that:

Regarding claim 1, Kawamura et al. discloses a camera comprising an imaging part (imaging portion 1, figure 2, page 2, section [0024]); a selector (selector switch 7, figures 1A, 2, page 2, sections [0024], [0025]); a recording part (photographing mode, page 2, section [0024]); a reproducing part (reproduction mode, page 2, section [0025]); a monitor (display portion 4, figures 2, 5, page 2, section [0024], [0025]); a display controller for controlling the monitor to display the image captured by the imaging part on a first

area on the monitor in the recording mode, and to display the image reproduced from the recording medium on a second area on the monitor in the reproducing mode (control portion 5, figure 2, 5, page 2, sections [0024], [0025]).

Appellant disagrees that *Kawamura* discloses a display controller for controlling the monitor to display the image captured by the imaging part on a first area on the monitor in the recording mode and to display the image reproduced from the recording medium on a second area on the monitor in the reproducing mode as required by independent claim 1.

In *Kawamura*, select switch 7 is operated to select one of the following modes: a photographing mode in which an object is photographed, a pen input mode that permits data entry with a pen, and a reproduction mode in which the display portion 4 displays photographed image data that is recorded in memory portion 6 or detachable PC card memory portion 7. [0023]. When the select switch 7 sets the camera to a photographing mode, control portion 5 incorporates a buffer for temporarily storing the image that has just been photographed and displays the image in display portion 4. [0024]. Where the select switch 7 sets the camera in reproduction mode, the control portion 5 reads the image recorded in the memory portion 6 and displays the image in the display portion 4. [0025]. Thus, regardless of whether the camera is set to the recording mode or the reproduction mode, the camera displays the image in display portion 4. Thus, *Kawamura* fails to teach or suggest a display controller for controlling the monitor to display the image captured by the imaging part on a first area on the monitor in the recording mode and to display the image

reproduced from the recording medium on a second area on the monitor in the reproducing mode.

Oku teaches a monitor device for a video tape recorder. When the recording mode is set by a mode switch 31a, the output of a video camera 2 is supplied to an electronic view finder 1 through a switch 5 and a picture of the video camera 2 is displayed on the electronic view finder 1. When confirmation of the recording state is indicated by a recording check switch 31b, the switch 5 is switched, and the reproduced picture from a reproducing circuit 41 of a VTR is projected on the electronic view finder 1. Thus, *Oku* teaches the image of the video camera and the reproduced image of the VTR being displayed simultaneously so that an operator can view the VTR image during recording. However, it is respectfully submitted that nowhere does *Oku* disclose a display controller for controlling the monitor to display the image captured by the imaging part on a first area on the monitor in the recording mode and to display the image reproduced from the recording medium on a second area on the monitor in the reproducing mode. As such, *Oku* fails to cure the deficiencies of the teachings of *Kawamura*.

Thus, since neither *Kawamura* nor *Oku*, either alone or in combination (assuming these references are combinable, which Appellant does not admit), teach or suggest a display controller for controlling the monitor to display the image captured by the imaging part on a first area on the monitor in the recording mode and to display the image reproduced from the recording

medium on a second area on the monitor in the reproducing mode, as recited in independent claim 1, claim 1 is patentable over *Kawamura* in view of *Oku*.

In providing the required motivation for combining the *Kawamura* and *Oku* references, the Examiner asserts:

Kawamura et al. fail to specifically disclose the first are [sic] being smaller than the second area. However, Oku et al. disclose that the display of the live recording image (by CAM) is smaller than the display of the reproduced image (by VTR), see figure 7c. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Kawamura et al. by the teaching of Oku et al. in order to let the time for processing image to be displayed in the photographing mode is small. The small size image (such as thumbnail) takes less time for processing to be displayed than large size image. This save[s] time for the operator to take the next image.

As noted above, it is well recognized that there are three possible sources for a motivation to combine references. The first source is the nature of the problem to be solved. As the Appellant sets forth in the specification, a camera is provided with a monitor, which enables the reproducing of a dynamic image on a large screen and makes it possible to confirm the entire image at the time of recording where the hand holding the camera does not cover and hide the image. [Specification, page 1, line 20 - page 2, line 6]. *Kawamura* addresses the problem of electronic cameras having a switch, command dial, or the like for use in inputting information which does not necessarily ensure a high operating efficiency. *Kawamura* solves the problem by providing an electronic camera with a data entry function by means of a pen-type designator. Thus, the underlying purpose of the electronic camera of *Kawamura*, which is related

to inputting information into an electronic camera, is entirely different than that of the claimed invention as *Kawamura* is not concerned with providing a monitor which enables the reproducing of a dynamic image on a large screen.

While the outstanding rejection recognizes that *Kawamura* fails to disclose a first area being smaller than a second area on a monitor, the rejection asserts it would have been obvious to modify *Kawamura* by incorporating teachings from the monitor device for a video tape recorder of *Oku*. Considering, however, that the purpose of *Kawamura* is to provide a more accurate system for entering information into an electronic camera, Appellant disagrees that such a modification would have been obvious because the operator of *Kawamura* is merely interested in the method of entering information into an electronic camera, not the appearance of the display in either a recording or a reproducing mode. Thus, Appellant respectfully submits that motivation cannot be found in the nature of the problem to be resolved.

In considering the second source of motivation to combine the references, it is respectfully submitted that no motivation can be found in the teachings of the prior art. As set forth above, *Kawamura* provides information relating to a pen input function that designates arbitrary positions on a display screen of the display device. As *Kawamura* teaches image data being displayed in only one area of the display portion, there is no teaching or suggestion for providing different areas on the display screen for displaying image data depending upon the mode the electronic camera is in.

Additionally, as noted above, the Examiner seeks to modify the device in *Kawamura* by the teachings of *Oku* in order to lessen the time for processing the image to be displayed in the photographing mode. The Examiner notes the small size image, such as a thumbnail, takes less time for processing to be displayed than a large size image. However, a disclosure of *Kawamura* teaches away from this combination. *Kawamura* teaches in the **image reproducing mode** that the photographed image data that have been photographed and stored in the memory portion 6 are displayed in thumbnail form (displayed in reduced size) (reference numeral 31 in Fig. 9). [0072]. Thus, *Kawamura* teaches the opposite of the proposition suggested by the Examiner. As such, since *Kawamura* teaches away from the modification as described by the Examiner, no motivation can be found in the *Kawamura* reference.

Oku teaches a monitor device for a video tape recorder in which, when in the recording mode, a user can, through switch 5, view the picture of the video camera 2 and the picture from VTR 4 simultaneously on the electronic view finder 1. As the images are being simultaneously displayed on a monitor, the fact that the image from video camera 2 would take less time for processing would be of no consequence since the purpose of the *Oku* device is to confirm whether pictures are surely recorded on a VTR or not. Thus, motivation cannot be found in *Oku*.

By asserting that it would have been obvious to modify *Kawamura* to include the features set forth in *Oku* with no suggestion or motivation in the

applied references or elsewhere to do so, the rejection appears to rely on impermissible hindsight reasoning.

For at least these reasons, Appellant submits that the rejection set forth in the Final Office Action fails to establish a *prima facie* case of obviousness of independent claim 1.

For at least these reasons, Appellant submits that the rejection set forth in the Final Office Action fails to establish *prima facie* obviousness of independent claim 1, as well as dependent claims 9 and 12 which depend from, and are grouped together with, claim 1.

4. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 6

Claim 6 depends directly from claim 1. Appellant submits that the rejection under 35 U.S.C. § 103(a) based on the combination of *Kawamura* in view of *Oku* fails to establish *prima facie* obviousness of claim 6 for at least the reasons set forth above concerning claim 1. Appellant also submits that dependent claim 6 is separately patentable and offers the following additional argument for the invention of claim 6.

The Examiner asserts that *Kawamura* discloses a touch panel, citing to touch panel 2, Fig. 5, page 1, section [0022]; wherein an operational button (buttons 25-27, Fig. 5) is displayed on an area other than the first area on the monitor in the recording mode, so that the monitor and touch panel serve as a camera operation part (Fig. 5). Appellant disagrees that *Kawamura* teaches the claimed elements set forth in claim 6.

Kawamura discloses in Fig. 5 a view showing an example of an image displayed when a menu button is pressed in an electronic camera. As shown in Fig. 5, the electronic camera includes touch switches for effecting switches of various modes. The touch switches are constructed by combining the pen input detecting portion 2 with a display portion 4 and a display sheet representing the functions of the switch that are provided below the detecting point 2. [0045].

In contrast, the present invention as set forth in dependent claim 6 recites, *inter alia*, wherein an operational button is displayed on an area other than the first area on the monitor in the recording mode, so that the monitor and the touch panel serve as a camera operation part. The touch panel of *Kawamura* as detected in Fig. 5 provides the user the opportunity to select various operating modes, namely, a record mode, a reproduction mode, etc. However, *Kawamura* does not teach or suggest displaying an operational button on the touch panel that serves as a camera operation part in the recording mode. As the Examiner has failed to provide a reference that teaches or suggests all of the claim elements, the Examiner has failed to establish *prima facie* obviousness. Thus, claim 6 is patentable over *Kawamura* in view of *Oku*.

5. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 7

Claim 7 depends directly from claim 6, which depends on claim 1. Appellant submits that the rejection under 35 U.S.C. § 103(a) based on the

combination of *Kawamura* in view of *Oku* fails to establish *prima facie* obviousness of claim 7 for at least the reasons set forth above concerning claim 1. Appellant also submits that claim 7 is separately patentable and offers the following additional argument for the invention of claim 7.

The Examiner admits that *Kawamura* and *Oku* fail to specifically disclose wherein the operational button comprises at least one of a zoom operation button and an exposure correcting button. The Examiner takes Official Notice that it is well known to use such zoom button to zoom an image. The Examiner concludes it would have been obvious to one of ordinary skill in the art at the time of the invention to include a zoom button in the device of *Kawamura* and *Oku* to let the user select a desired size of the displayed image. Appellant respectfully disagrees with the Examiner's characterization of these references.

As noted above, the references fail to teach or suggest an operational button being displayed on an area other than the first area on the monitor in the recording mode so that the monitor and the touch panel serve as a camera operation part as recited in claim 6. While Appellant agrees a zoom button in and of itself is well known as a feature of a camera, the Examiner has failed to establish the teaching of an operational button on a touch panel to serve as a camera operation part. As the Examiner has failed to provide a reference that teaches an operational button so that the touch panel serves as a camera operation part, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Further, in support of the Examiner's combination of a well-known zoom button and the teachings of *Kawamura* and *Oku*, the Examiner asserts one would have been motivated to combine these teachings in order to let the user select the desired size of the display. However, this statement fails to provide any motivation as to why one of ordinary skill would have been motivated to incorporate a zoom button as an operation button displayed on an area on the monitor so that the touch panel serves as a camera operation part. As such, the Examiner has failed to provide proper motivation and thus has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Thus, claim 7 is patentable over *Kawamura* in view of *Oku*.

6. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 8

Claim 8 depends directly from claim 1. Appellant submits that the rejection under 35 U.S.C. § 103(a) based on the combination of *Kawamura* in view of *Oku* fails to establish *prima facie* obviousness of claim 8 for at least the reasons set forth above concerning claim 1. Appellant also submits that dependent claim 8 is separately patentable and offers the following additional argument for the invention of claim 8.

The Examiner admits that *Kawamura* and *Oku* fail to specifically disclose an operational button for instructing the image reproduced on the monitor to be enlarged. The Examiner takes Official Notice that it is well known in the art to use such an enlarging button to enlarge an image. The Examiner concludes it would have been obvious to one of ordinary skill in the art at the time of the

invention to include an enlarging button in the devices of *Kawamura* and *Oku* in order to let the user see a better view of the image. Appellant respectfully disagrees with the Examiner's characterization of these references.

Assuming, *arguendo*, that it is well known in the art to have an enlargement button to enlarge an image displayed on a monitor, based upon the failure of the teachings of *Kawamura* and *Oku* to disclose an operational button, the Examiner has failed to provide a reference that teaches or suggests an operational button for enlarging a reproduced image on the monitor. As such, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Thus, claim 8 is patentable over *Kawamura* in view of *Oku*.

B. Issue (2): The *Kawamura-Oku-Okada* Rejection

1. Argument Summary

The reasoning provided in support of the rejection of claims 2-4 under 35 U.S.C. § 103(a) as being unpatentable over *Kawamura* in view of *Oku* and further in view of *Okada* fails to establish *prima facie* obviousness. (a) Regarding claims 2-4, the rejection is deficient because the rejection attributes certain claimed features to *Okada* that a detailed reading of the reference reveals are not taught therein; (b) when the nature and purpose of the information inputting technique disclosed in *Kawamura* is recognized, it is evident that there is no suggestion or motivation in the prior art references cited in support of the rejection or in knowledge generally available to those skilled in the art to modify *Kawamura* in a manner asserted in the rejection;

and (c) by asserting that certain modifications to the information input device of *Kawamura* would have been obvious without a suggestion in the applied references or elsewhere to make the asserted modifications, the rejection appears to rely on impermissible hindsight reasoning.

2. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 2

Claim 2 depends directly from claim 1. Appellant submits that the rejection under 35 U.S.C. § 103(a) based on the combination of *Kawamura* in view of *Oku* and further in view of *Okada* fails to establish *prima facie* obviousness of claim 2 for at least the reasons set forth above concerning claim 1. Appellant also submits that dependent claim 2 is separately patentable and offers the following additional argument for the invention of claim 2.

In support of the Examiner's rejection of claim 2, the Examiner admits that *Kawamura* and *Oku* fail to disclose a grip to be held by a hand of an operator in the recording mode, the grip being arranged at a front of a body of the camera wherein the monitor is arranged at a back of the body of the camera and extends to a part opposite the grip. The Examiner relies on *Okada* to cure the deficiencies of the teachings of *Kawamura* and *Oku* by asserting *Okada* discloses a camera having a grip (Fig. 1) where the monitor (LCD 15) is arranged at the back of the body of the camera and extends to a part opposite the grip (Fig. 2). The Examiner concludes it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in *Kawamura* and *Oku* by the teachings of *Okada* in order to let the operator

hold the camera easier when taking and viewing pictures at the same time. Appellant respectfully disagrees with the Examiner's characterization of these references.

The disclosure set forth in *Okada* is directed to a camera having color correction coefficients set in accordance with a combination of photographic parameters. As shown in Fig. 1, the camera includes a grip (depicted at a position below shutter release 19). As can be seen in Fig. 2, LCD 15 is positioned such that it is essentially centered at the rear of the camera such that it does not interfere with the hand holding the camera at the grip.

In contrast, the invention set forth in claim 2 recites, *inter alia*, wherein the monitor is arranged at a back of the body of the camera and extends to a part opposite to the grip. It is respectfully submitted that there is no teaching or suggestion in *Okada* that is directed to a monitor being arranged at a back of the body of the camera and extending to a part opposite to the grip. As *Okada* fails to cure the deficiencies of the teachings of *Kawamura* and *Oku*, it is respectfully submitted that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103(a). As such, claim 2 is patentable over *Kawamura* in view of *Oku* and *Okada*.

Furthermore, regarding the proposed modifications of *Kawamura* and *Oku* that the Examiner has concluded would have been obvious in view of the teachings of *Okada*, Appellant again notes that the underlying purpose of the camera of *Kawamura*, which is directed to an information input device, is entirely different than that of the claimed invention as *Kawamura* is not

concerned with providing for a dynamic image on a large screen making it possible to confirm the entire image at the time of recording as the hand holding the camera does not cover and hide the image.

Since the purpose of the camera of *Kawamura* is merely for providing for a more efficient and accurate device for inputting information in the camera, Appellant disagrees that there is any suggestion or motivation to combine the camera of *Kawamura* to incorporate the purported display as set forth in *Okada* as the user of *Kawamura* is merely interested in inputting the information, not viewing the information on a display.

Further, there is no teaching or suggestion found in *Okada* which is solely directed to arranging a monitor on the camera to allow an operator to hold the camera easier while taking and viewing pictures displayed on the monitor at the same time, or in the knowledge generally available to those skilled in the art that would have been motivated to modify *Kawamura* in the manner relied on in the rejection of claim 2. By asserting that it would have been obvious to modify *Kawamura* to include this alleged feature of *Okada* with no suggestion or motivation in the applied references or elsewhere to do so, the rejection again appears to rely on impermissible hindsight reasoning.

As such, Appellant submits that *Okada*, taken alone or in combination with *Kawamura* and *Oku* (assuming these references are combinable, which Appellant does not admit), fails to establish *prima facie* obviousness of dependent claim 2.

3. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 3

Claim 3 depends from claim 2, which depends from claim 1. Appellant submits that the rejection under 35 U.S.C. § 103(a) based on the combination of *Kawamura* in view of *Oku* and *Okada* fails to establish *prima facie* obviousness of claim 3 for at least the reasons set forth above concerning claim 1. Appellant also submits that dependent claim 3 is separately patentable and offers the following additional argument for the invention of claim 3.

In support of the Examiner's rejection of claim 3, the Examiner recites on page 6 of the Final Official Action:

Regarding claim 3, *Okada* disclose[s] the monitor is arranged such that none of the first area and a part of the second area are covered with the hand of the operator holding the camera by the grip in the recording mode (figure 2, LCD 15 is not covered by the hand of the operator holding the camera by the grip).

The Appellant respectfully disagrees with the Examiner's characterization of this reference.

As noted above, an operator holding the camera depicted in Figs. 1-2 does not cover any portion of LCD 15. This is admitted by the Examiner where the Examiner notes that LCD 15 is not covered by the hand of the operator holding the camera by the grip. However, the invention set forth in claim 3 recites, *inter alia*, "and a part of the second area are covered with the hand of the operator holding the camera by the grip in the recording mode." While the Examiner admits that the hand of the operator does not cover LCD 15, the Examiner fails to provide any citation in the *Okada* reference that teaches a

part of the second area being covered with the hand of the operator holding the camera. Thus, the Examiner has failed to establish *prima facie* obviousness by failing to provide a reference that teaches or suggests all of the claimed elements.

Additionally, the Examiner has failed to provide any motivation as to why one of ordinary skill in the art would be motivated to combine the teachings of *Okada* with *Kawamura* and *Oku* to include this feature. Thus, again, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Thus, claim 3 is patentable over *Kawamura*, *Oku*, and *Okada*.

4. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 4

Claim 4 depends from claim 1. Appellant submits that the rejection under 35 U.S.C. § 103(a) based on the combination of *Kawamura* in view of *Oku* and *Okada* fails to establish *prima facie* obviousness of claim 4 for at least the reasons set forth above concerning claim 1. Appellant also submits that dependent claim 4 is separately patentable and offers the following additional argument for the invention of claim 4.

It is respectfully submitted that claim 4 contains elements similar to those discussed above with regard to claim 3. Thus, claim 4 is patentable as the Examiner has failed to establish *prima facie* obviousness for claim 4.

C. Issue (3): The *Kawamura-Shigetomi* Rejection1. Argument Summary

The reasoning provided in support of the rejection of claim 10 under 35 U.S.C. § 103(a) as being unpatentable over *Kawamura* in view of *Shigetomi* fails to establish *prima facie* obviousness. The rejection of claim 10 is deficient because (a) the rejection attributes certain claimed features to *Shigetomi* that a detailed reading of the reference reveals are not taught therein; (b) when the nature and purpose of the photo finishing technique as disclosed by *Kawamura* is recognized, it is evident that there is no suggestion or motivation in the prior art references cited in support of the rejection or in knowledge generally available to those skilled in the art to modify *Kawamura* in a manner asserted in the rejection; and (c) by asserting that certain modifications to the information input device of *Kawamura* would have been obvious without a suggestion in the applied references or elsewhere to make the asserted modifications, the rejection appears to rely on impermissible hindsight reasoning.

2. The Rejection Fails to Establish *Prima Facie* Obviousness of Independent Claim 10

Independent claim 10 is directed to a camera that comprises, *inter alia*, a touch panel arranged over the monitor and a display controller for determining, by the touch panel, an area on the monitor hidden by a matter touching the touch panel and controlling the monitor to display the image on an area on the monitor excluding the hidden area.

In support of the Examiner's rejection of claim 10, the Examiner provides on page 7 of the Final Official Action as follows:

Kawamura et al. fail to specifically to [sic] disclose a display controller for determining, by the touch panel, an area on the monitor hidden by a matter touching the touch panel, and controlling the monitor to display the image on an area on the monitor excluding the hidden area. However, Shigetomi disclose[s] a liquid crystal display device with a display screen on which a touch panel is disposed (figures 5-6, column 1, line 65 through column 2, line 9). Figures 5-6 show the display screen has two regions, one region for displaying icons 3B-3H (an area on the monitor hidden by a matter touching the touch panel), the other region for displaying image 3A (display the image on an area on the monitor excluding the hidden area). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Kawamura et al. by the teaching of Shigetomi in order to prevent the displayed image from being covered by any icons or buttons. This let[s] the operator can [sic] view a better image.

Appellant respectfully disagrees with the Examiner's characterization of the *Shigetomi* reference.

The disclosure of *Shigetomi* is directed to a liquid crystal display device and entertainment system wherein a video image and an image containing icons are displayed on a display screen in such a manner that they do not overlap with each other. [Abstract]. *Shigetomi* specifically provides at col. 1, line 62 - col. 2, line 9 as follows:

The transmitting unit reads a video image from a storage section, the video image being obtained by compressing and encoding a video image provided with an aspect ratio of 4:3, and each of the receiving units includes a liquid crystal display device with a display screen having an aspect ratio of 16:9 and on which a touch panel is disposed. The liquid crystal display device includes an image output section for displaying the video image and several icon images, wherein

the video image and the icon images have the same aspect ratio of 4:3 as that of a source image, and wherein the video image and the icon images are displayed on the display screen with an aspect ratio of 16:9 in a manner that the video image and the icon images are arranged side by side without overlapping.

As noted above, *Shigetomi* teaches displaying image data and icons separately on a display. However, the present invention set forth in claim 10 provides for a display controller for determining, by the touch panel, an area on the monitor hidden by a matter touching the touch panel. There is no teaching or suggestion in *Shigetomi* that is directed to a display controller for determining, by the touch panel, an area on the monitor hidden by a matter touching the touch panel. Further, *Shigetomi* fails to teach or suggest controlling the monitor to display the image on an area on the monitor excluding the hidden area. As such, since *Shigetomi* fails to cure the deficiencies of the teachings of *Kawamura* (assuming these references are combinable, which Appellant does not admit), it is respectfully submitted that the Examiner has failed to establish prima face obviousness under 35 U.S.C. § 103(a). Thus, claim 10 is patentable over *Kawamura* in view of *Shigetomi*.

In considering the proposed modification of *Kawamura* that the Examiner has concluded would have been obvious in view of *Shigetomi*, Appellant again notes that the underlying purpose of the information input device of *Kawamura* is concerned with efficiently and accurately inputting information into a camera and is entirely different than that of the claimed

invention because *Kawamura* is not concerned with how information is displayed on a monitor.

Since the purpose of the information input device of *Kawamura* is merely directed to an information input device, Appellant disagrees that there is any suggestion or motivation to modify the camera of *Kawamura* to incorporate the purported display features as set forth in *Shigetomi* as the operator of *Kawamura* is merely interested in entering information into the camera, not how the information is displayed on the monitor.

Thus, there is no teaching or suggestion found in *Kawamura*, *Shigetomi*, or knowledge generally available to those skilled in the art that would have provided motivation to modify *Kawamura* in the manner relied on in the rejection of claim 10. By asserting it would have been obvious to modify *Kawamura* to include this purported feature of *Shigetomi* with no suggestion or motivation in the applied references or elsewhere to do so, the rejection again appears to rely on impermissible hindsight reasoning.

D. Issue (4): The *Kawamura-Shigetomi-Okada* Rejection

1. Argument Summary

The reasoning provided in support of the rejection of claim 11 under 35 U.S.C. § 103(a) as being unpatentable over *Kawamura* in view of *Shigetomi* and further in view of *Okada* fails to establish *prima facie* obviousness. Regarding claim 11, the rejection is deficient because (a) the rejection attributes certain claim features to *Okada* that a detailed reading of the reference reveals are not taught therein; (b) when the nature and purpose of the information input

technique disclosed by *Kawamura* is recognized, it is evident that there is no suggestion or motivation in the prior art references cited in support of the rejection or in knowledge generally available to those skilled in the art to modify *Kawamura* in a manner asserted in the rejection; and (c) by asserting that certain modifications to the information input system of *Kawamura* would have been obvious without a suggestion in the applied references or elsewhere to make the asserted modifications, the rejection appears to rely on impermissible hindsight reasoning.

2. The Rejection Fails to Establish *Prima Facie* Obviousness of Dependent Claim 11

Claim 11 depends directly from claim 10. Appellant submits that the rejection under 35 U.S.C. § 103(a) based on the combination of *Kawamura* in view of *Shigetomi* and further in view of *Okada* fails to establish *prima facie* obviousness of claim 11 for at least the reasons set forth above concerning claim 10. Appellant also submits that dependent claim 11 is separately patentable, and offers the following additional argument for the invention of claim 11.

In support of the Examiner's rejection of claim 11, the Examiner asserts on page 8 of the outstanding Final Official Action as follows:

Regarding claim 11, Kamura [sic] et al. disclose the monitor is arranged at the back of the camera (figure 5, page 1, section [0022]). Kawamura et al. and Shigetomi fail to specifically disclose a grip to be held by a hand of an operator, the grip being arranged at a front of a body of the camera; wherein the monitor is arranged at a back of the body of the camera and extends to a part opposite to the grip. However, Okada discloses a camera has a grip (figure 1)

and monitor (LCD 15) is arranged at a back of the body of the camera and extends to a part opposite to the grip (figure 2). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device in Kawamura et al. and Shigetomi by the teaching of Okada in order to let the operator hold the camera easier when taking picture and viewing picture at the same time.

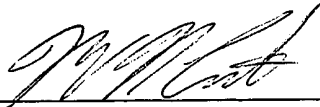
As discussed above with regard to claim 2, *Okada* fails to cure the deficiencies of the teachings of *Kawamura* as *Okada* fails to disclose wherein the monitor is arranged at a back of the body of the camera and extends to a part opposite the grip. As the Examiner has failed to provide a reference that teaches or suggests all of the claimed elements, it is respectfully submitted that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103(a). Thus, claim 11 is patentable over *Kawamura* in view of *Shigetomi* and *Okada*.


X. CONCLUSION

For the reasons specifically set forth above, the outstanding rejections set forth in the Final Office Action should be reversed.

Respectfully submitted,

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Appendix of Claims

1. (Original) A camera comprising:

an imaging part for capturing an image of a subject;

a selector for selecting one of a recording mode and a reproducing mode;

a recording part for recording the image captured by the imaging part on a recording medium upon receiving a command to record in the recording mode;

a reproducing part for reproducing an image from the recording medium in the reproducing mode;

a monitor for displaying an image; and

a display controller for controlling the monitor to display the image captured by the imaging part on a first area on the monitor in the recording mode, and to display the image reproduced from the recording medium on a second area on the monitor in the reproducing mode, the first area being smaller than the second area.

2. (Original) The camera as defined in claim 1, further comprising:

a grip to be held by a hand of an operator in the recording mode, the grip being arranged at a front of a body of the camera;

wherein the monitor is arranged at a back of the body of the camera and extends to a part opposite to the grip.

3. (Original) The camera as defined in claim 2, wherein the monitor is arranged such that none of the first area and a part of the second area are

covered with the hand of the operator holding the camera by the grip in the recording mode.

4. (Original) The camera as defined in claim 1, wherein the monitor is arranged on a body of the camera such that none of the first area and a part of the second area are covered with a hand of an operator holding the body to operate the camera in the recording mode.

5. (Original) The camera as defined in claim 1, further comprising:

a touch panel arranged over the monitor;

wherein, in the recording mode, the display controller determines an area on the monitor covered with a hand of an operator by the touch panel and bounds the first area on the monitor such that the first area excludes the covered area.

6. (Original) The camera as defined in claim 1, further comprising:

a touch panel arranged over the monitor;

wherein an operational button is displayed on an area other than the first area on the monitor in the recording mode, so that the monitor and the touch panel serve as a camera operation part.

7. (Original) The camera as defined in claim 6, wherein the operational button comprises at least one of a zoom operation button and an exposure correcting button.

8. (Original) The camera as defined in claim 1, further comprising:

a touch panel arranged over the monitor;

wherein at least one of an operational button for instructing the image reproduced on the monitor to be switched on a frame-by-frame basis in an order, an operational button for instructing the image reproduced on the monitor to be switched on a frame-by-frame basis in a reverse order, an operational button for instructing the image reproduced on the monitor to be enlarged, and an operational button for instructing the image reproduced on the monitor to be reduced, is displayed on the monitor in the reproducing mode.

9. (Original) The camera as defined in claim 1, wherein the monitor comprises a liquid crystal display.

10. (Original) A camera comprising:

an imaging part for capturing an image of a subject;

a monitor for displaying the image captured by the imaging part;

a touch panel arranged over the monitor; and

a display controller for determining, by the touch panel, an area on the monitor hidden by a matter touching the touch panel, and controlling the monitor to display the image on an area on the monitor excluding the hidden area.

11. (Original) The camera as defined in claim 10, further comprising:

a grip to be held by a hand of an operator, the grip being arranged at a front of a body of the camera;

wherein the monitor is arranged at a back of the body of the camera and extends to a part opposite to the grip.

12. (Previously Presented) The camera as set forth in claim 1 wherein the first area is arranged to exclude an area covered with a hand of an operator holding a body of the camera to operate the camera to record the image.